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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,338	03/01/2002	John p. Ruckart	010417	4121
36192	7590	01/04/2006	EXAMINER	
CANTOR COLBURN LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002				HASHEM, LISA
		ART UNIT		PAPER NUMBER
		2645		

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/086,338	RUCKART, JOHN P.
	Examiner	Art Unit
	Lisa Hashem	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 26 October 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 6-22 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 6-22 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 30 June 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 17 is objected to because of the following informalities: Claim 17 recites the limitation "the incoming call". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6, 14, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Claim 6 contains the subject matter '...wherein the parameters include both a predetermined schedule including at least one time period during which the incoming call is placed on hold...' and '...automatically answering the call if the call corresponds to the one or more parameters of the hold function...', claim 14 contains the subject matter '...the determining based on both a schedule including at least one predetermined time period during which the incoming call is placed on hold...', and claim 17 contains the subject matter '...wherein said parameters include both a predetermined schedule including at least one time period during which the incoming call is placed on hold...' and '...means for automatically answering a call

placed by a calling party to a called party, if the call corresponds to the one or more parameters...’.

None of these limitations are disclosed in the specification of the instant application and the drawings. The only mention of time period is on page 15 of the instant application, ‘...After alerting the user of the incoming call, the device determines, at step 310 whether the user desires to place the call on hold prior to answering. The device may do so by determining whether a button or a key on the device is depressed by the user during a specified period of time. The period of time may be, for example, the period between the first and second times (e.g. rings) that the device alerts the user of the incoming call...’. There is no mention of a schedule in this passage.

The only mention of automatically answering the call is on page 15 of the instant application, ‘...At step 300, the device detects an incoming call. At step 302, it is determined if the user of the device (i.e. the called party) has enabled the call hold function. If the user has enabled the function, the device answers the call at step 304 and plays a message to the calling party at step 306. An example of such a message could be, “Hello, this is Joe Smith, I am unable to answer the telephone at the moment, so you have been placed on hold. I will answer you call momentarily.” The message placed at step 304 may be a message that is stored on the device or may be a message played by, for example, the SN 34. A message may also be displayed on the device that alerts the user of the device that a call has been placed on hold. Such a message could be, for example, “123-456-7890 Has Been Placed On Hold”. There is no mention of automatically answering the call if the call corresponds to the one or more parameters of the hold function. Appropriate correction is required.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-10, 12, 13, and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,266,098 by Novak in view of U.S. Patent No. 6,760,581 by Dutta.

Regarding claim 6, Novak discloses a method of placing an incoming call to a telecommunications device (Fig. 2) from a calling party on hold prior to being answered by a called party (e.g. user), the method comprising:

receiving one or more parameters of a hold function (e.g. wherein an incoming call is not connected to a called party) wherein the parameters include both a predetermined schedule including at least one time period during which the incoming call is placed on hold (e.g. hours wherein a called party will not accept calls but will accept a caller recording a message), and a list including at least one potential calling party from whom incoming calls are placed on hold (col. 2, lines 53-68);

automatically answering the call;

playing a message to the called party (col. 3, lines 1-3); and

connecting the called party to the calling party when the called party answers the call (col. 3, lines 9-36).

Novak does not disclose automatically answering the call if the call corresponds to the one or more parameters of the hold function.

Dutta discloses a method of placing an incoming call to a telecommunications device (e.g. mobile telephone; Fig. 2, 200) from a calling party on hold prior to being answered by a called party (e.g. user) (Fig. 6), the method comprising: receiving one or more parameters of a hold function wherein the parameters include both a hold command including at least one time period during which the incoming call is placed on hold (e.g. time period wherein Bluetooth commands are received by the mobile telephone), and a list including at least one potential calling party from whom incoming calls are placed on hold (col. 2, lines 21-36; col. 5, line 1 – col. 6, line 13); automatically answering the call if the call corresponds to the one or more parameters of the hold function; playing a message to the called party; and connecting the called party to the calling party when the called party answers the call (col. 5, line 60 – col. 6, line 2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the apparatus of Novak to include automatically answering the call if the call corresponds to the one or more parameters of the hold function as taught by Dutta. One of ordinary skill in the art would have been lead to make such a modification to automatically answer an incoming call if the call corresponds to the one or more parameters when a hold function is enabled.

Regarding claim 7, the method of claim 6, wherein Novak further discloses determining whether the called party has enabled a hold function (col. 2, lines 42-46; col. 2, line 53 – col. 3, line 33).

Regarding claim 8, the method of claim 6, wherein Dutta further discloses determining whether the called party has pressed a button (Fig. 2, 250) on the telecommunications device to enable a hold function (col. 4, lines 22-25).

Regarding claim 9, the method of claim 6, wherein Novak further discloses means for alerting the called party of the incoming call (col. 3, lines 1-25).

Regarding claim 10, the method of claim 6, wherein Novak further discloses connecting the calling party to a voicemail system (Fig. 2, 16) when the called party does not answer the call within a predetermined time period (col. 3, lines 1-8; col. 3, lines 25-33).

Regarding claim 12, the method of claim 6, wherein Novak further discloses playing a message to the calling party includes playing a pre-recorded message (Fig. 2, 1) stored in a memory device resident on the telecommunications device (col. 2, line 42 – col. 3, line 25).

Regarding claim 13, the method of claim 6, wherein Dutta further discloses connecting the call to a voicemail system when the called party presses a button on the telecommunications device (col. 5, line 67 – col. 6, line 2).

Regarding claim 21, the method of claim 6, wherein Dutta further discloses the receiving one or more parameters of the hold function is performed via a web interface (col. 6, line 14 – col. 7, line 9).

Regarding claim 17, Novak discloses an apparatus (Fig. 2), comprising: means for receiving one or more parameters of a hold function (e.g. wherein an incoming call is not connected to a called party), wherein said parameters include both a predetermined schedule including at least one time period during which an incoming call is placed on hold (e.g. hours wherein a called party will not accept calls but will accept a caller recording a message), and a

list including at least one potential calling party (e.g. the calling parties have assigned code numbers) from whom incoming calls are placed on hold (col. 2, lines 53-68);  
means for automatically answering a call placed by a calling party to a called party (col. 1, lines 48-57; col. 3, lines 1-3);  
means for playing a message to the calling party (col. 3, lines 1-3); and  
means for connecting the called party to the calling party when the called party answers the call (col. 3, lines 9-36).

Novak does not disclose means for automatically answering a call placed by a calling party to a called party, if the call corresponds to the one or more parameters.

Dutta discloses an apparatus or mobile telephone (Fig. 2, 200), comprising:  
means for receiving one or more parameters of a hold function wherein the parameters include both a hold command including at least one time period during which the incoming call is placed on hold (e.g. time period wherein Bluetooth commands are received by the mobile telephone), and a list including at least one potential calling party from whom incoming calls are placed on hold (col. 2, lines 21-36; col. 5, line 1 – col. 6, line 13);  
means for automatically answering a call placed by a calling party to a called party, if the call corresponds to the one or more parameters;  
means for playing a message to the called party; and  
means for connecting the called party to the calling party when the called party answers the call (col. 5, line 60 – col. 6, line 2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the apparatus of Novak to include means for automatically answering a call

placed by a calling party to a called party, if the call corresponds to the one or more parameters as taught by Dutta. One of ordinary skill in the art would have been lead to make such a modification to automatically answer an incoming call if the call corresponds to the one or more parameters when a hold function is enabled.

Regarding claim 18, the apparatus of claim 17, wherein Novak further discloses means for determining whether the called party has enabled a hold function (col. 2, lines 42-46; col. 2, line 53 – col. 3, line 33).

Regarding claim 19, the apparatus of claim 17, wherein Dutta further discloses means for determining whether the called party has pressed a button (Fig. 2, 250) on the telecommunications device to enable a hold function (col. 4, lines 22-25).

Regarding claim 20, the apparatus of claim 17, wherein Novak further discloses means for alerting the called party of the incoming call (col. 3, lines 1-25).

Regarding claim 22, the apparatus of claim 17, wherein Dutta further discloses the means for receiving one or more parameters of the hold function receives the one or more parameters via a web interface (col. 6, line 14 – col. 7, line 9).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Novak in view of Dutta as applied to claim 6 above, and further in view of U.S. Patent Application Publication No. 2002/0077157 by Okun et al, hereinafter Okun.

Regarding claim 11, the method of claim 6, wherein Novak in view of Dutta do not disclose playing a message to the calling party includes playing a message that is resident on a services node of a telecommunications network.

Okun discloses a telecommunications system (see Figure 1a; section 0013, lines 1-8), comprising a home location register (Figure 1A, 110) for storing a profile of a user of a telecommunications device (Figure 1A, 126), wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system (e.g. a subscriber profile indicates determining whether a text or voice message is preferred for a calling party in order to send a message to a calling party that is on hold) (section 0014, lines 1-6; section 0036, lines 1-8; section 0039, line 1 – section 0040, line 11; section 0044, lines 1-14; section 0077, lines 1-12); a services node or serving MSC (Figure 1A, 118) for: determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service; placing the incoming call on hold prior to the call being answered; playing a message to the calling party (section 0054, line 1 – section 0057, line 13); and connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call (section 0058, line 1 – section 0063, line 10); and a mobile switching center or originating MSC (Figure 1A, 102) for facilitating communication between the telecommunications device, the services node, and the home location register (section 0054, lines 5-12).

Wherein Okun further discloses playing a message to the calling party includes playing a message that is resident on a services node (Fig. 1A: 118, 120) of a telecommunications network (section 0057, lines 1-13).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Novak in view of Dutta to include playing a message to the

calling party includes playing a message that is resident on a services node of a telecommunications network as taught by Okun. One of ordinary skill in the art would have been lead to make such a modification to enable the hold function by instructing a service node to play a message to the calling party, wherein the hold function is directed by the service node.

8. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okun in view of Novak.

Regarding claim 14, Okun discloses a telecommunications system (see Figure 1a; section 0013, lines 1-8), comprising a home location register (Figure 1A, 110) for storing a profile of a user of a telecommunications device (Figure 1A, 126), wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system (e.g. a subscriber profile indicates determining whether a text or voice message is preferred for a calling party in order to send a message to a calling party that is on hold) (section 0014, lines 1-6; section 0036, lines 1-8; section 0039, line 1 – section 0040, line 11; section 0044, lines 1-14; section 0077, lines 1-12); a services node or serving MSC (Figure 1A, 118) for: determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service; placing the incoming call on hold prior to the call being answered; playing a message to the calling party (section 0054, line 1 – section 0057, line 13); and connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call (section 0058, line 1 – section 0063, line 10); and a mobile switching center or originating MSC (Figure

1A, 102) for facilitating communication between the telecommunications device, the services node, and the home location register (section 0054, lines 5-12).

Okun does not disclose the determining based on both a schedule including at least one predetermined time period during which the incoming call is placed on hold and a list including at least one potential calling party from whom incoming calls are placed on hold.

Novak discloses a telecommunications device (Fig. 2), wherein a memory (Fig. 2, 12) includes an indication of whether a user is a subscriber to an incoming call hold service (e.g. wherein an incoming call is not connected to a called party) implemented by the telecommunications device; determining whether an incoming call placed to the telecommunications device by a calling party should be answered by the user of the telecommunications device according to the incoming call hold service, the determining based on both a schedule including at least one predetermined time period during which the incoming call is placed on hold and a list including at least one potential calling party (e.g. the calling parties have assigned code numbers) from whom incoming calls are placed on hold (col. 2, lines 42-68); placing the incoming call on hold prior to the call being answered; playing a message to the calling party (col. 3, lines 1-3); and connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call (col. 3, lines 9-36).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the telecommunication system of Okun to include the determining based on both a schedule including at least one predetermined time period during which the incoming call

is placed on hold and a list including at least one potential calling party from whom incoming calls are placed on hold as taught by Novak. One of ordinary skill in the art would have been lead to make such a modification to include parameters under which the incoming hold service will be implemented, the parameters including a schedule of predetermined time periods and a list of potential calling parties.

Regarding claim 15, the system of claim 14 mentioned above, wherein Okun further discloses the services node includes an enunciator or IVR (section 0057, lines 5-9; section 0061, lines 10-14).

Regarding claim 16, the system of claim 15 mentioned above, wherein Okun further discloses the enunciator is for playing a message to a calling party when a call is placed on hold (section 0057, lines 5-9; section 0061, line 10 – section 0062, line 10).

#### *Response to Arguments*

9. Applicant's arguments with respect to claims 6-22 have been considered but are moot in view of the new ground(s) of rejection.

10. Accordingly, this action is **NON-FINAL**.

#### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 5,978,451 by Swan et al disclose 'do not disturb', 'time of day', and blocking features that are determined by a schedule including at least one predetermined time period during which the incoming call is placed on hold (e.g. holding the incoming call, wherein the incoming call is not connected to a called party)

- U.S. Patent No. 6,763,105 by Miura et al disclose an answering-phone-function that is determined by a schedule including at least one predetermined time period during which the incoming call is placed on hold (e.g. holding the incoming call, wherein the incoming call is not connected to a called party)

12. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh

December 18, 2005



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